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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,774	05/30/2001	Masayuki Kumazawa	2001_0680A	4986

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WASHINGTON, DC 20006-1021

EXAMINER
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NALVEN, ANDREW L

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/866,774

Applicant(s)

KUMAZAWA ET AL.

Examiner

Andrew L Nalven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-28 are pending.

### ***Response to Arguments***

2. Applicant's arguments have been considered but they are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-9, 11-14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palage et al US Patent No. 6,247,133 in view of Katz et al US Patent No. 5,926,624. Palage discloses a method for authenticating electronic documents on a computer network. Katz teaches a digital information library and delivery system.
4. With regards to claims 1, 6, 11 and 16, Palage teaches an index retrieval part for retrieving index data indicating said content data prior to retrieving the content data (Palage, column 5 lines 30-47, document identifier), an authenticating part for authenticating said content based on the index data retrieved by said index retrieval part

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(Palage, column 6 lines 50-57), and a content retrieval part for retrieving said content data from said server only if said authentication part has confirmed authenticity of the said content data (Palage, column 7 lines 35-54). Palage fails to teach the index data retrieved prior to retrieving content data and content retrieval only being requested if the authentication part has confirmed the authenticity of the content data. Katz teaches teach the index data retrieved prior to retrieving content data (Katz, column 8 line 63 – column 9 line 6, searching for content) and content retrieval only being requested if the authentication part has confirmed the authenticity of the content data (Katz, column 11 lines 47-54, column 8 lines 32-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Katz's method of retrieving index data and authenticating with Palage's electronic document system because it offers the advantage of providing security for digital information downloaded to a client and providing a method of previewing content before downloading (Katz, column 1 lines 46-67).

5. With regards to claims 2-3, 7-8, 12-13, and 17-18, Palage as modified teaches content data being assigned a locator indicating information for specifying a storage location thereof (Palage, column 6 lines 50-57, document identifier), index data including embedded data which is embedded with said locator as an electronic watermark and to which the content data is linked (Palage, column 8 lines 62-67), and an extraction part for extracting, as a watermark locator, the locator embedded as the electronic watermark from the embedded data included in the index data retrieved by said index retrieval part (Palage, column 9 lines 11-13), a text locator extraction part for

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extracting as a text locator, a locator specified as being indicative of the content data linking to the embedded data from the index data retrieval part if said extraction part has successfully extracted the watermark locator (Palage, column 9 lines 11-15, column 7 lines 24-34), a check part for determining whether the text locator extracted by said text locator extraction part matches with the watermark locator extracted by said extraction part (Palage, column 9 lines 3-15, comparing encoded information to stored information), and an authenticity confirmation part for confirming the authenticity of said content data only if said check part determines that the text locator matches with the watermark locator (Palage, column 7 lines 35-54).

6. With regards to claims 4, 9, 14, and 19, Palage as modified teaches a display part for displaying a predetermined warning if said authentication part has not confirmed the authenticity of said content data (Palage, column 7 lines 48-66, column 8 lines 3-5).

7. Claims 5, 10, 15, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palage et al US Patent No. 6,247,133 and Katz et al US Patent No. 5,926,624, as applied to claims 2, 3, 7-8, 12-13, and 17, in further view of Moskowitz et al US Patent No. 5,905,800. Moskowitz teaches a digital watermarking system.

8. With regards to claims 5, 10, 15, and 20-24, Palage as modified fails to teach the embedded data being moving-picture data and/or audio data. Moskowitz teaches embedded data being moving-picture data and/or audio data (Moskowitz, column 2 lines 35-58). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Moskowitz's method of embedding watermarks in video or audio data because it offers the advantage of providing a

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method of embedding identification information in order to allow support of distribution systems of media content (Moskowitz column 1 lines 9-25).

9. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palage et al US Patent No. 6,247,133 and Katz et al US Patent No. 5,926,624, as applied to claims 6, 11, 16, and 18, in further view of Klug US Patent No. 6,591,245.

10. With regards to claims 25-28, Palage as modified fails to teach the index data provided by email. Klug teaches the index data provided by email (Klug, column 6 lines 12-18). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Klug's email method with Palage as modified because it offers the advantage of providing content notifications directly to a specific consumer based upon their interests (Klug, column 2 lines 3-15).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Nalven whose telephone number is 571 272 3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571 272 3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Andrew Nalven

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*Andrew Caldwell*

**ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER**